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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,303	01/26/2007	Hiromi Matsuzaki	P30093	5121
7055 7590 05/19/2009 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER WOLF, MEGAN YARNALL				
ART UNIT 3738		PAPER NUMBER		
NOTIFICATION DATE 05/19/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com

pto@gbpatent.com

Office Action Summary

Application No.

10/596,303

Applicant(s)

MATSUZAKI ET AL.

Examiner

Megan Wolf

Art Unit

3738

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-14, 16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14, 16 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/2/09 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8, 10, 14, 16, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrison et al. 2005/0038517 in view of Kim et al. 5,645,596 and further in view of Tofighi et al. 2003/0120351.

Re claim 1, Carrison discloses the invention substantially as claimed including a bone replacement material to be used by being packed into a bone defective part, wherein the bone replacement material is a rigid biocompatible material (par.45) and is formed into a pellet wherein the pellet has a roughly polyhedral shape and is defined by a plurality of surfaces including a pair of opposite, non-parallel surfaces, one of the opposite, non-parallel surfaces being inclined at a predetermined angle with respect to the other of the opposite, non-parallel surfaces (fig.3), wherein the bone replacement material is in a state such that a number of pellets of the bone replacement material are capable of being introduced into a cavity of the bone defective part and aggregated therein (figs.15-18). However, while Carrison discloses that the material may be porous

(par.52), Carrison does not disclose that the bone replacement material is calcium phosphate and has a porosity equal to or less than 75%.

Kim teaches a vertebral prosthesis, in the same field of endeavor, wherein calcium phosphate is used as an implant material for the purpose of its spontaneous adhesion to the associated vertebrae, and wherein the porosity of the calcium phosphate is preferably between 30 and 45% for the purpose of simultaneously providing mechanical strength and promoting tissue ingrowth (col.4, ll.32-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use calcium phosphate with a porosity of less than 75% as taught by Kim for the vertebral implants of Boyle in order to allow for tissue ingrowth for anchoring the implant while maintaining mechanical strength to resist compression forces. As Kim discloses the claimed porosity as well as the Ca/P ratio claimed in claim 19, one would assume that the collapsing strength of the calcium phosphate compound of Kim is equal to or more than 15 MPa. Still, Carrison in view of Kim does not specifically state that the collapsing strength of the calcium phosphate based compound has a collapsing strength of 15MPa or more.

Tofghi teaches a calcium phosphate compound for use in an implant, in the same field of endeavor, wherein the final porous calcium phosphate compound has a compression strength of greater than 20MPa for the purpose of being useful as a weight bearing implant material (par.56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to specify that the calcium phosphate compound of Carrison in view of Kim

have a collapsing strength greater than 15Mpa in order to provide a material that is strong enough for use as an implant that is required to bear weight as taught by Tofighi.

Re claims 2-4, 10 and 14, see Carrison fig.3.

Re claims 5-8, while Carrison does not specifically disclose that the implant is either a pentahedral, cylindrical, or a triangular prism shape, these shapes are simply a matter of design choice and as it has been held that changes in shape are a matter of design choice, which a person of ordinary skill in the art would have found obvious as they were not disclosed as being critical to the practice of the invention (In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) MPEP 2144.04 IV B).

Re claims 16, 20, and 21, see Carrison figs. 13-18. Note that while Carrison does not disclose that the implants are inserted into the hollow passage of a cylindrical member such that the inclined surface of a pellet faces the inclined surface of an adjacent pellet, because of their shape shown in fig.3, the pellets of Carrison are capable of such use.

Re claim 19, see Kim col.4, ll.25-30.

4. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrison et al. 2005/0038517 in view of Kim et al. 5,645,596 and further in view of Tofighi et al. 2003/0120351 as applied to claim 1 above, and further in view of Shimp 2004/0052829. Carrison in view of Kim in further view of Tofighi discloses the invention substantially as claimed and as discussed above, but does not disclose the specific size of the pellets to be between 2 and 10 mm or the volume of each pellet to be in the range of 13 to 239 mm³.

Shimp teaches calcium phosphate pellets (par.28), in the same field of endeavor, wherein the pellets can vary in size but are preferably up to 4mm (yielding a volume of 64mm^3), for the purpose of providing an injectable load bearing support at the repair site (par.10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to specify the claimed size ranges for the pellets of Carrison as this size is best suited for injecting bone replacement material into a bone defect in the spine as taught by Shimp.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Megan Wolf whose telephone number is (571)270-3071. The examiner can normally be reached on Monday-Friday 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. W./
Examiner, Art Unit 3738

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738